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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/630,345	07/29/2003	Joseph A. Zupanick	067083.0205	9309

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EXAMINER

KRECK, JOHN J

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 08/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/630,345

**Applicant(s)**

ZUPANICK, JOSEPH A.

**Examiner**

John Kreck

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.  
4a) Of the above claim(s) 1-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 26-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on \_\_\_\_ is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

**DETAILED ACTION**

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-25, drawn to process and system for gas production, classified in class 166, subclass 50.
  - II. Claims 26-58, drawn to process of drilling, classified in class 175, subclass 66.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because it does not require underbalanced drilling. The subcombination has separate utility such as drilling a single bore for coal analysis.

Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

2. During a telephone conversation with Terry Stalford on 8/23/04 a provisional election was made without traverse to prosecute the invention of group II, claims 26-58. Affirmation of this election must be made by applicant in replying to this Office action.

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Claims 1-25 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

1. Claims 26-58 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,561,288; U.S. Patent number 6,357,523; U.S. Patent number 6,280,000; U.S. Patent number 6,668,918; U.S. Patent number 6,478,085; and U.S. Patent number 6,357,523.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims are generally similar in scope or somewhat broader.

2. Claims 26-58 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/641,856; 10/323,192, and 10/256,412. Although the conflicting

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claims are not identical, they are not patentably distinct from each other because they are generally similar in scope or somewhat broader.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 35, 38-39, 54 are rejected under 35 U.S.C. 102(b) as being anticipated by Stanley (United States Patent number 5,411,104).

Stanley teaches a process including drilling a well including a horizontal bore in a coal seam and reducing downhole pressure as called for in claim 35. See abstract.

Stanley teaches the coal is porous and fractured as called for in claim 38.

Regarding independent claim 39:

Stanley teaches the drilling and producing gas as called for in claim 39.

Regarding independent claim 54:

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Stanley teaches the drilling a horizontal bore in a coal formation and lightening hydrostatic pressure as called for in claim 54.

4. Claims 40, 42, 43, 44, 45, and 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Smith (U.S. Patent number 5,435,400).

Smith teaches a method including drilling and pumping as called for in claim 40.

Smith teaches the pumping through a second bore (second bore is 2, first bore is 34) as called for in claim 42.

Smith teaches that the second bore comprises a vertical bore as called for in claim 43.

Smith teaches the first bore is articulated as called for in claim 44.

Smith also teaches the main horizontal (e.g. 34) and plurality of laterals (e.g. 52, and 41) as called for in claim 45.

Smith also teaches the gas lift as called for in claim 49.

5. Claims 40, 41, 46, 48, and 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Mueller, et al. (U.S. Patent number 5,355,967).

Mueller teaches the drilling and pumping as called for in claim 40 (see abstract).

Mueller teaches the pressure is reduced as called for in claim 41.

Mueller teaches a pressure of 100psi (col. 4, line 10) as called for in claim 46.

Mueller teaches the downhole pump (jet pump) as called for in claim 48.

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Mueller teaches the absence of loss of fluids as called for in claim 50.

6. Claims 40, 42, 43, 51, and 52 are rejected under 35 U.S.C. 102(b) as being anticipated by Allen (U.S. Patent number 4,134,463).

Allen teaches drilling and pumping as called for in claim 40.

Allen teaches the pumping through a second bore as called for in claim 42.

Allen teaches that the second bore comprises a vertical bore (e.g. near 24) as called for in claim 43.

Allen teaches the junction as called for in claim 51.

Allen teaches the cavity as called for in claim 52. Note that the bore at the bottom of well 18 is a "cavity", even though it is not enlarged.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 26, 27, 31, 32, 33, 34, 47, and 54-56 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mueller in view of Stanley.

Mueller teaches a method of drilling a well including pumping and reducing pressure. Mueller does not specify a specific formation type for the drilling method and

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thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, as called for in claim 26.

Mueller teaches the lightening the pressure of the fluid as called for in claim 27.

Mueller teaches the pumping with a downhole pump as called for in claim 31.

Mueller teaches the reducing pressure to nearly zero as called for in claim 32.

Mueller teaches the below overbalanced conditions as called for in claim 33.

Mueller teaches the reducing the pressure to approximately 150-200 psi as called for in claim 34.

Regarding claim 47, which depends form claim 40:

Mueller does not specify a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas.



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It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, as called for in claim 47.

Regarding independent claim 54:

Mueller teaches the drilling and lightening. Mueller fails to teach the horizontal bore. Mueller also does not specify a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful to prevent overbalanced well problems.

Stanley teaches that overbalanced well problems are common in drilling coal seams; and teaches that it is desirable to drill in coal seams to obtain gas. Stanley also teaches that horizontal bores are useful in coal gas wells, in order to increase production.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Mueller process in a coal seam, in order to obtain gas, and to have modified the Mueller process to have included drilling a horizontal bore as called for in claim 54, in order to increase production.

Mueller teaches pumping as called for in claim 55.

Mueller teaches pumping using a downhole pump as called for in claim 56.

8. Claims 26, 28-30, 35-37, 53-55, 57, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith in view of Stanley.

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Smith teaches pumping and reducing pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 26; in order to get coal gas.

Smith teaches reducing pressure by gas lift as called for in claim 28.

Smith teaches reducing pressure by aerating the fluid(i.e. by gas lift) as called for in claim 29.

Smith teaches reducing pressure by circulating compressed air(i.e. by gas lift) as called for in claim 30.

Regarding independent claim 35:

Smith teaches drilling a well including a horizontal bore and reducing pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 35; in order to get coal gas.

Smith teaches a pattern including a horizontal bore as called for in claim 36.

Smith also teaches reducing pressure as called for in claim 37.

Regarding independent claim 53:

Smith teaches drilling a horizontal bore and pumping fluid and cuttings. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 53; in order to get coal gas.

Regarding independent claim 54:

Smith teaches drilling a horizontal bore and lightening pressure. Smith does not teach a specific formation type for the drilling method and thus fails to explicitly teach the drilling in a coal seam, but teaches that the method is useful in a "formation 3 from which one or more minerals such as oil, natural gas...".

Stanley teaches that coal has natural gas.

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It would have been obvious to one of ordinary skill in the art at the time of the invention to have used the Smith method in a coal seam as called for in claim 54; in order to get coal gas.

Smith teaches lightening by pumping as called for in claim 55.

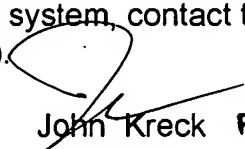
Smith teaches lightening by gas lift as called for in claim 57.

Smith teaches pumping through a second bore (2) as called for in claim 58.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Kreck whose telephone number is (703)308-2725. The examiner can normally be reached on M-F 5:30 am - 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on (703)308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
John Kreck  
Examiner  
Art Unit 3673

**JOHN KRECK  
PRIMARY EXAMINER**

JJK